UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,926	01/10/2001	Stuart Mandel Garland	47-10	8084

7590 05/01/2006	**EXAMINER**
Werner Ulrich	DUONG, THOMAS
434 Maple Street	

ART UNIT	PAPER NUMBER
2145	

Glen Ellyn, IL 60137-3826

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td colspan="2">Application No.
09/757,926</td><td colspan="2">Applicant(s)
GARLAND ET AL.</td></tr>
<tr><td colspan="2">Examiner
Thomas Duong</td><td>Art Unit
2145</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-2, 5, 7-8, and 11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 5, 7-8, and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the applicants Appeal Brief filed on February 8, 2006.

Claims 1-2, 5, 7-8, and 11 are presented for further consideration and examination.

2.   Applicant's request for reconsideration of the finality of the rejection of the last Office

action is persuasive and, therefore, the finality of that action is withdrawn.

3.   In view of the appeal brief filed on February 8, 2006, PROSECUTION IS HEREBY

REOPENED. New grounds of rejection are set forth below.

Response to Argument

4.   Applicant's argument, see pg.6 – pg.12, filed on February 8, 2006, with respect to *claims*

1-2, 5, 7-8, and 11 have been fully considered and are persuasive. The finality of

previous rejection is withdrawn.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   *Claims 1-2 and 7-8* are rejected under 35 U.S.C. 102(e) as being unpatentable over Nguyen (US006377978B1).

7.   With regard to *claims 1 and 7,* Nguyen discloses,

- *if the customer station is idle, delivering a message directly to the customer station;* (Nguyen, col.2, lines 24-42; col.5, line 13 – col.6, line 14) Nguyen discloses a method wherein *"the mail client 130 transmits a request to the mail server 110, requesting transmission of the headers 141 for any electronic mail messages 140 which have been received and are available for downloading. In a preferred embodiment, the mail client 130 transmit such a request when it is first invoked, at periodic times, and when the operator so requests"* (Nguyen, col.5, lines 13-19). Hence, Nguyen teaches of retrieving electronic mail messages from a server when it is first invoked, at periodic times, or upon the user's request.

- *if the customer station is busy receiving another message, determining a precedence level for a received message, and storing the received message in storage associated with that precedence level;* (Nguyen, col.2, lines 24-42; col.5, line 13 – col.6, line 14; col.6, line 60 – col.7, line 43) Nguyen discloses, *"dynamic downloading of electronic messages 140 continues so long as there are electronic messages 140 available at the email server 110 for which the operator is the intended destination"* (Nguyen, col.6, lines 11-14). Furthermore, Nguyen discloses, *"in a preferred embodiment, the mail client 130*

dynamically orders the electronic mail messages 140 for downloading, and

selects those electronic mail messages 140 for downloading which the mail client

130 dynamically considers should be downloaded first" (Nguyen, col.6, lines 60-

64). Hence, Nguyen teaches of classifying the messages by their downloading

preferences and priorities and storing them for download accordingly.

- *if the customer station is busy receiving said another message, notifying the*

  customer that said message is being received by a system for storing received

  messages; (Nguyen, col.2, lines 24-42; col.5, line 13 – col.6, line 14; col.6, line

  60 – col.7, line 43)

  Nguyen discloses, *"when the mail client 130 receives the headers 141, it reviews*

  the downloading preferences and their relative priorities, and downloads those

  electronic mail messages 140 which are indicated by the downloading

  preferences in the order of their relative priorities" (Nguyen, col.7, lines 26-31).

  Hence, Nguyen teaches that, in the presence of an electronic mail message of

  higher priority, an alert from the mail client in the form of header or its preloading

  indicator is presented to the user for desired action, which may include

  immediate selection by the user and downloading of the electronic mail message

  by the mail client.

- *if said customer, responsive to said notifying, signals for immediate delivery of*

  said message to said customer station, immediately delivering said message to

  said customer station; (Nguyen, col.2, lines 24-42; col.5, line 13 – col.6, line 14;*

  col.6, line 60 – col.7, line 43)

  Nguyen discloses, *"the selection by the operator of a particular electronic mail*

  message 140 for presentation takes priority over other download operations.

The mail client 130 interrupts any other download operation to conduct the

download operation requested by the operator. Thus, the mail client 130 may

interrupt downloading and presentation of the headers 141 in the header window

151, downloading of a different electronic mail message 140 selected for

downloading by the mail client 130, or even downloading of a different electronic

mail message 140 selected for downloading by the operator (but for which the

operator has apparently decided is lower priority" (Nguyen, col.5, lines 53-54).

Hence, Nguyen teaches of immediately interrupting the download of any current

message and downloading the new user selected message.

- *subsequently, when the customer station is idle, delivering messages to the*

  customer station from storage of higher precedence level before delivering

  messages from storage of lower precedence level. (Nguyen, col.2, lines 24-42;

  col.5, line 13 – col.6, line 14; col.6, line 60 – col.7, line 43)

  Nguyen discloses, *"dynamic downloading of electronic messages 140 continues*

  so long as there are electronic messages 140 available at the email server 110

  for which the operator is the intended destination" (Nguyen, col.6, lines 11-14).

  Furthermore, Nguyen discloses, *"in a preferred embodiment, the mail client 130*

  dynamically orders the electronic mail messages 140 for downloading, and

  selects those electronic mail messages 140 for downloading which the mail client

  130 dynamically considers should be downloaded first" (Nguyen, col.6, lines 60-

  64). Hence, Nguyen teaches of continuing to download the messages by their

  downloading preferences and priorities.

8.   With regard to *claims 2 and 8*, Nguyen discloses,

> • *wherein certain classes of messages also have a preemption level, wherein if*
>
> *said customer station receives a message with a preemption level, the reception*
>
> *of said another message is interrupted if the precedence level of the received*
>
> *message is above a precedence level of said another message currently being*
>
> *received by the customer, unless the customer, responsive to said notifying,*
>
> *signals for a deferral of delivery of said message.* (Nguyen, col.2, lines 24-42;
>
> col.5, line 13 – col.6, line 14; col.6, line 60 – col.7, line 43)

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   *Claims 5 and 11* are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nguyen (US006377978B1) and in view of Parsons et al. (US006970906B1).

11.   With regard to *claims 5 and 11,* Nguyen discloses,

> See *claims 1 and 7* rejection as detailed above.
>
> However, Nguyen does not explicitly disclose,
>
> • *wherein the step of notifying comprises the step of: notifying only if the received*
>
>   *message is at or above a pre-determined precedence level.*
>
> Parsons teaches,

- *wherein the step of notifying comprises the step of: notifying only if the received*

     message is at or above a pre-determined precedence level. (Parsons, col.2, lines

     3-45)

     Parsons discloses, *"the notification system sends a notification of the new*

     messages (or perhaps only a subset thereof, in accordance with preferences

     established by the user) to a wireless device configured and selected by the user

     for receiving message notifications" (Parsons, col.2, lines 11-15). Hence,

     Parsons teaches of sending notifications to the user based on the preferences,

     which may include priority level, precedence level, or a determined level,

     established by the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

the invention was made to combine the teachings of Parsons with the teachings of

Nguyen to *"provide a technique for downloading electronic mail messages which*

allows an operator to review at least portions of those electronic mail messages

without waiting to download the entire electronic mail message" (Nguyen, col.2, lines

11-15). Therefore, this method is advantageous in that it saves the operator from

spending valuable time on reviewing electronic mail messages of lesser priority.

Instead, the operator can concentrate on reviewing the preferred electronic mail

messages predefined by the operator's preferences.
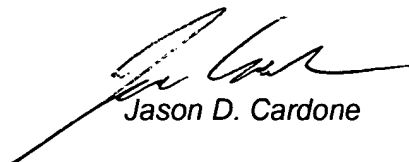
Conclusion

12.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Thomas Duong whose telephone number is 571/272-3911. The

examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone

can be reached on 571/272-3933. The fax phone numbers for the organization where

this application or proceeding is assigned are 571/273-8300 for regular communications

and 571/273-8300 for After Final communications.

Thomas Duong (AU2145)

April 26, 2006

Jason D. Cardone

Supervisory PE (AU2145)